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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ESCALANTE, OVIDIO

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/393,633

Applicant(s)

SARP ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-25 and 27-31 is/are rejected.
- 7) ☒ Claim(s) 11 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on October 21, 2002. **Claims 1-31** are now pending in the present application.

Claim Objections

2. Claim 1 is objected to because of the following informalities: in line 11, a comma should be inserted after "system" (first occurrence) since the sentence reads as "...said voice mail system said voice mail system...". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. Claims 1-7,10,12-15,17-23,25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohsawa US Patent 5,463,676 in view of LaBarbera US Patent 5,757,897.

Regarding claims 1 and 17, Ohsawa teaches a telephone switching system (key telephone system) and computer implemented method for facilitating and controlling voice and data communication among and between telephone sets, (T_1 - T_n key sets and telephone sets originating externally from lines L_1 - L_m , fig. 1), both internal to said system and external to said system, (col. 1, lines 63-67; col. 2, lines 30-34), said system comprising:

a telephone exchange switch (main equipment 1) controllable by a central processing unit (CPU) contained within said telephone exchange switch, (control 5; col. 1, lines 63-67; col. 2, lines 30-34), said CPU also being used for forming predetermined messages, (col. 2, lines 35-54);

a voice mail system (voice storage equipment 2) in electronic communication with said telephone exchange switch (1) using a data communications link for message exchange between said telephone exchange switch and said voice mail system, (fig. 1; col. 2, lines 44-54; the

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exchange switch sends the voice mail system messages such as sender and absence mode information), said voice mail system including means for forming predetermined messages for said message exchange, said message exchange also serving to control said telephone exchange switch, (col. 2, line 64-col. 3, lines 4,18-23; the voice mail system sends messages to the switch so that message information can be displayed); and

at least one telephone set (T_n) in electronic communication with said telephone exchange switch, (1 main equipment), said telephone set including means (display; fig. 3) for displaying alphanumeric characters in a human readable form, (101,102; number and name; col. 3, lines 5-16), said means for displaying being operable responsive to at least one message received from said telephone exchange switch resulting from said message exchange between said telephone exchange switch and said voice mail system, (col. 2, line 64-col. 3, line 16), said telephone set further including at least one manual switch (104 buttons) for sending a signal to said telephone exchange switch responsive to said message received from said telephone exchange switch resulting from said message exchange between said telephone exchange switch and said voice mail system, (col. 3, lines 5-28; the receiver sees the recording status and sender name) , said signal being indicative of a predetermined response to said message from said voice mail system, (col. 3, lines 9-14; in response to receiving the display message the recipient will press a button to receive the entire message).

Ohsawa teaches that the senders name and number is transmitted to the control 9, which is in the voice mail system, through an ISDN. It is further well known in the art that an ISDN line includes both a voice line and a data line from transmission of information therefore it would

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have been obvious to one skilled in the art that Ohsawa would have a voice link and data link at least from the outside line to the switch.

Nonetheless, LaBarbera teaches that it was well known in the art to have both a data link and a voice link from a voice mail system to a switching system, (fig. 2; col. 11, lines 58-65; col. 12, lines 44-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Ohsawa to include both a voice link and a data link as taught by LaBarbera so that the voice mail message can be audibly played to the recipient when the recipient manually presses a button on the telephone when a control signal is received via the data link.

Regarding claim 2, Ohsawa teaches wherein said data communications link is a serial communications link, (fig. 1; the link is a data link).

Regarding claim 3, Ohsawa teaches wherein means for forming predetermined messages for said message exchange includes preprogrammed computer processors, (col. 2, line 64-col. 3, line 4; message exchange occurs by the controllers);

said means for displaying alphanumeric characters in a human readable form includes a display device associated with said telephone set for displaying messages from said voice mail system directed to a user of said telephone set to convey information regarding conditions associated with said voice mail system, (col. 3, lines 5-16; fig. 3); and

said at least one manual switch (104) is operatively associated with a displayed message for a predetermined user response, (col. 3, lines 5-16).

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Regarding claims 4,6,20 and 22, Ohsawa teaches wherein said voice mail system includes means for obtaining a calling party's number from an incoming telephone signal, (col. 2, lines 29-34), said means for forming predetermined messages includes means for forming a message for data transmission to said telephone exchange switch to cause said display device to display characters indicative of said calling party's number and of a response message, (col. 3, lines 1-4; fig. 3), wherein activation of said at least one manual switch causes transmission of said predetermined response message, (col. 3, lines 5-16).

Regarding claims 5 and 21, while Ohsawa teaches of obtaining a calling party's number from an incoming call as taught above, Ohsawa does not specifically teach of prompting the caller to enter predefined numbers.

LaBarbera teaches that it was well known in the art to have means for obtaining a calling party's number from an incoming telephone signal including means for selectively prompting a caller to enter predefined digits, (col. 11, lines 9-14,47-52). Therefore, it would have been obvious to prompt a caller for a telephone number in the system of Ohsawa and thus have means for obtaining a calling party's number from an incoming telephone signal includes means for collecting said predefined digits for transmission to said telephone set through said data link and said telephone exchange switch for display on said display device, (col. 2, lines 5-16, Ohsawa).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ohsawa by prompting the calling party for their number as taught by LaBarbera so that the system can be able to send to the recipient the calling party's number if the system is not able to automatically determine the calling party's number.

Regarding claims 7 and 23, Ohsawa teaches wherein said voice mail system includes means for controlling said means for displaying alphanumeric characters in a human readable form in the absence of a connection between a telephone set and a mailbox associated with said telephone set, (col. 2, lines 29-31).

Regarding claims 10 and 25, Ohsawa, as applied above, teaches that each of said telephone sets having a designated message location associated with said voice mail system, each said message location being accessible by a respective telephone set for communication therebetween, (fig. 2; col. 2, lines 55-63). Ohsawa does not specifically teach of including an automated call distribution system with the key telephone system.

LaBarbera teaches wherein said system includes an automated call distribution system associated with said voice mail system and a plurality of telephone sets connected to said telephone exchange switch, (col. 1, lines 52-62; fig. 1), said system further comprising means for determining a state associated with each said telephone set being controlled by said automated call distribution system, said state defining whether each said telephone being controlled by said automated call distribution system is in a busy condition and means for communicating said state for each telephone set being controlled by said automated call distribution system to said voice mail system as a state message using said data link, (col. 2, lines 15-27; abstract), said voice mail system further including means for monitoring each said state message (col. 9, lines 5-15) and transferring incoming telephone calls to telephone sets for which said respective state message indicates as being idle, (col. 9, lines 33-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ohsawa by incorporating an automatic call

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distributor into the system as taught by LaBarbera so that ACD capabilities can be provided to key systems and so that incoming calls can be routed to the appropriated recipient, (col. 1, lines 34-49, LaBarbera).

Regarding claims 12,13,27 and 28, Ohsawa in view of LaBarbera teaches wherein said system includes an automated call distribution system associated with said voice mail system and a plurality of telephone sets connected to said telephone exchange switch, (fig. 1, Ohsawa), each of said telephone sets having a designated message location associated with said voice mail system, (fig. 2), wherein said voice mail system includes means for controlling information displayed on said display device operable by a user of at least one said telephone set without said at least one telephone set being interconnected by a voice connection to its respective message location, (col. 2, line 64-col. 3, line 19, Ohsawa). Ohsawa further teaches of sending an initial message to open said display device and to send information regarding the system, (col. 2, line 64-col. 3, line 16)

Regarding claims 14 and 29, Ohsawa teaches wherein said system includes a plurality of telephone sets connected to said telephone exchange switch, (fig. 1), each of said telephone sets having a designated message location associated with said voice mail system, said system further comprising means for supplying information regarding each respective telephone set from said switch to said voice mail system for updating information used by said voice mail system with respect to each said telephone set, (col. 2, line 64-col. 3, line 19; fig. 2).

Regarding claim 15, Ohsawa teaches wherein said voice mail system maintains a database of information relating to each said telephone set and a respective designated message

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location thereof, and said means for supplying information regarding each respective telephone set includes means for supplying information to update said database, (fig. 2; col. 2, lines 55-63).

Regarding claim 18, Ohsawa teaches wherein said method further includes the step of:
sending a signal using said at least one manual switch, (104), said signal being sent to said telephone exchange switch (1) in response to said message received from said telephone exchange switch resulting from said message exchange between said telephone exchange switch and said voice mail system, said signal being indicative of a predetermined response to said message received from said telephone exchange switch, (col. 3, lines 5-16).

Regarding claim 19, Ohsawa teaches wherein said method further includes the steps of:
providing preprogrammed computer processors as said means for forming predetermined messages for said message exchange, (col. 2, lines 35-54);

providing a display device as said means for displaying alphanumeric characters in a human readable form, said display device (fig. 3) being associated with said telephone set, (col. 3, lines 5-6);

displaying messages from said voice mail system directed to a user of said telephone set to convey information regarding conditions associated with said voice mail system, (fig. 3);

providing at least one manual switch being operatively associated with a displayed message for a predetermined user response, (col. 3, lines 5-16); and

responding to said conveyed information using said at least one manual switch, (col. 3, lines 5-16).

4. Claims 8,9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohsawa in view of LaBarbera and further in view of Rogers US Patent 5,946,386.

Regarding claims 8,9 and 24, Ohsawa teaches wherein said system includes a plurality of telephone sets connected to said telephone exchange switch, each of said telephone sets having a designated message location associated with said voice mail system, each said message location being accessible by a respective telephone set for communication there between, (col. 2, line 64-col. 3, line 16).

Ohsawa does not specifically teach of distributing a message form a first telephone set to a second telephone set.

Rogers teaches said system further comprising means for distributing a message from a first telephone set for receipt by at least one second telephone set without said first telephone set having accessed a designated message location associated therewith, (col. 13, lines 16-19, said message being deliverable to a message location associated with said at least one second telephone set using said data link responsive to a user of said first telephone set activating said at least one manual switch, (col. 13, lines 16-19; col. 28, lines 55-61); and wherein said message is a voice memo directed from said first telephone set to said second telephone set and said switch includes means to initiate a call to said voice mail system, said call including a designated message location associated with said second telephone set, (col. 44, lines 41-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ohsawa by allowing a first telephone set to send a message to a second telephone set as taught by Rogers so that a first party can send each other messages if the second party is not available.

5. Claims 16,30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohsawa in view of LaBarbera and further in view of O'Donovan et al. US Patent 6,396,908.

Regarding claims 16,30 and 31, while Ohsawa and LaBarbera teaches of connecting to remote telephones, Ohsawa and LaBarbera do not specifically teaches of sending messages from a first switching system to a second switching system.

Nonetheless, O'Donovan teaches that it was well known in the art to have a telephone exchange system and wherein said telephone exchange switch is a first telephone exchange switch, (PBX 12; fig. 1; col. 1, lines 7-8), said system further comprising:

a second telephone exchange switch (PBX 22) remotely disposed from said first telephone exchange switch, (fig. 1; col. 5, lines 17-31);

means for electronically connecting said second telephone exchange switch to said first telephone exchange switch through the Internet, (col. 5, lines 23-31; fig. 1);

at least one second telephone set (21) in electronic communication with said second telephone exchange switch, (20, fig. 1), said second telephone set including means for displaying alphanumeric characters in a human readable form, said means (onscreen display) for displaying being operable responsive to at least one message received from said second telephone exchange switch resulting from said message exchange between said second telephone exchange switch and said voice mail system, (col. 7, lines 13-23; an onscreen display notifies the user of a received message; col. 6, line 61-col. 7, line 12), through the Internet (40) and said first telephone exchange switch, said second telephone set further including at least one manual switch (keypad) for sending a signal to said second telephone exchange switch responsive to said message received from said second telephone exchange switch resulting from said message exchange between said second telephone exchange switch and said voice mail system through the Internet and said first telephone exchange switch, said signal being indicative of a

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predetermined response to said message from said voice mail system, (col. 7, lines 13-23; the user retrieves the received message in response to the onscreen display notification);

connecting said second telephone exchange switch with said first telephone exchange switch using said Internet connection;, (col. 1, lines 7-8; col. 6, lines 61-col. 7, line 12)

forming predetermined messages for said message exchange using said voice mail system and said second telephone exchange switch, (col. 5, lines 23-31);

exchanging said predetermined messages between said voice mail system and said second telephone exchange switch through said first telephone exchange switch and said Internet connection, (col. 5, lines 23-31; col. 6, line 61-col. 7, line 12);

and operating said means for displaying responsive to at least one message received from said second telephone exchange switch resulting from said message exchange between said second telephone exchange switch and said voice mail system, (col. 7, lines 13-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ohsawa and LaBarbera by connecting to a remote switching system for transferring messages via the Internet as taught by O'Donovan so that a less expensive form of message transmission can be utilized and so that user's can transfer or send messages to other remote voice mail systems without incurring expensive toll charges from long distance calls.

Allowable Subject Matter

6. Claims 11 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

7. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

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(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.
The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group
is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO
employees do not engage in Internet communications where there exists a possibility that
sensitive information could be identified or exchanged unless the record includes a properly
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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Technology Center 2600 Customer Service Office whose telephone
number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
January 15, 2003

FAN TSANG
SUPERVISOR PATENT EXAMINER
TECHNOLOGY CENTER 2600

